



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,296	03/20/2001	Ted R. Rittmaster	GTUS03	2288

7590 10/01/2009  
Anna Vradenburgh  
Brull, Piccionelli Sarno Braun  
1925 Century Park East  
Suite 2350  
Los Angeles,, CA 90067

EXAMINER
----------

LE, KHANH H

ART UNIT	PAPER NUMBER
----------	--------------

3688

MAIL DATE	DELIVERY MODE
-----------	---------------

10/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/812,296	<b>Applicant(s)</b> RITTMASER ET AL.	
	<b>Examiner</b> KHANH H. LE	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-59 is/are rejected.
- 7) ☒ Claim(s) 40-59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 30, 2009 (herein, "Response") has been entered.

Claims 40-57 were pending. New claims 58-59 are added. Thus claims 40-59 are pending. Claims 40, 49 and 59 are independent.

## **Claim Objections**

### **2. Claims 49-57 are objected to because of the following informalities:**

#### **a. Claim 49, last 2 lines and claim 59 last para.:**

It is not clear how information can be "partial access but not full access" or "full access" since information cannot be access. Inserting "information" or "level information" after "full access" would overcome the objection. This objection made earlier has not been responded to. Applicant argues, as to claim 40, at page 8 "access .. various levels of access ". That means "first information" in claim 40 is a particular type of information to which several levels of access is possible. To distinguish from the "first information" in claim 40, the above appropriate correction is required.

Claims 50-57 are objected to as being dependent upon rejected base claim 49.

b. Claims 40, 49, 59: "the geographic location" in the determining step lacks clear antecedent basis since a "general geographic location" was mentioned earlier.

Claims 41-48, 50-58 are objected to as being dependent upon rejected base claims 40, 49, 59. Appropriate correction is required.

### Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**4. Previous Rejections of Claims 40-57 under 35 U.S.C. 112, first paragraph are withdrawn:**

Claim 40: Applicant is convincing at Response p. 7-8 in arguing that claim 40 is supported by the specification.

Since “first information” can be information with several levels of access (partial or full), claim 40 could be interpreted, as: inside a region (e.g. X ), full access information (first information) with” predefined” additional information is provided; and outside region X (e.g. inside region Y), partial access information (first information) is provided without “predefined” additional information. Specification at [0059] read together with [0058] satisfies the 1<sup>st</sup> prong of claim 40 (i.e. full access information is provided inside region X with requiring additional information) and also the second prong of claim 40 (i.e. outside region X (e.g. inside region Y per [0059]), partial access without additional information.

**Claim 49: Upon further consideration, Examiner believes Claim 49 is supported by [0059] read together with [0058]:**

Claim 49 claims:

*“...requiring predefined additional information before providing the given recipient processor with access to first information in the event that the given recipient processor is determined to be within the predefined location or region; and providing the given recipient processor with access to second information without requiring the predefined additional information in the event that the given recipient processor is not determined to be within the predefined location or region, wherein the one of the first and second information is a partial access but not full access to a product or service and the other of the first and second information is full access to the product or service.”*

Art Unit: 3688

Applicant argued earlier that claim 49 is supported by the original application, including original claim 1 and paragraphs [0058] and [0059].

**Interpretation of claim 49 in view of specification [0059] read together with [0058]:**

Per [0059], first information and “second information can be full (or partial access) information. Claim 49 means that if “first information” is full access information then “second information” is partial access information and vice versa.

[0059] read together with [0058] may fairly be read as disclosing: regions X, Y, Z, wherein **inside region X, full access information with (or without) “predefined” additional information may be provided; inside region Y (i.e. outside X) partial access information with (or without) predefined additional information** may be provided;” and no access for user devices (such as 16) located outside of regions X and Y” (per [0058]).

i. Assuming “first information” of claim 49 is full access information (i.e. “second information” is partial access), claim 49 is interpreted in view to the specification as: inside a region (e.g. X), full access information is provided with predefined additional information; then inside region Y (outside region X) partial access is provided without “predefined” additional information.

Since [0059] read together with [0058] discloses full access information may be provided inside region X with predetermined additional information, and outside X, (i.e. inside region Y) it may be provided partial access information without (per [0058]) “predefined” additional information, this means [0059] read together with [0058] encompasses this particular claimed combination as a possible permutation.

ii. Likewise, assuming “first information” of claim 49 is partial access information (i.e. “second information” is full access information) claim 49 is interpreted, in view of the specification, as: inside region Y, partial access information with predefined additional information; then inside region X (outside region Y) full access information without “predefined” additional information;

Since [0059] read together with [0058], discloses as stated above: full access information may be provided inside region X without predetermined additional information, and outside X, (i.e. inside region Y) it may be provided partial access information with “predefined” additional information [0059]; this means [0059] read together with [0058] encompasses this particular claimed combination as a possible permutation.

Further, Applicant’s arguments (Response, pages 9-10) are also persuasive.

## **5. Response to Arguments**

**5a. (The new matter issue is addressed above).**

**5b. As to the prior art applied, Applicant's arguments filed June 30, 2009 have been fully considered but they are not persuasive as to the prior art applied.**

### **Claim interpretation:**

#### **Method claims 40, 49 and 59:**

It is noted that either the requiring additional information step or the providing step (last step) needs not be given patentable weight since the claim still claims in the alternative.

That is, in order for both branches of within /not within (the predetermined region or location) to be required to given weight to, the claim would have to recite that the plurality of processors included both processors that are within, and those that are not. Here it is not claimed that the plurality of processors include both processors that are within the predetermined region and those that are outside that region.

Since the claim is broad enough to also deal with the 2 instances where 1) all the plural processors are within or 2) all are not within, the providing step may not occur, when instance 1) occurs. Conversely, the requiring additional information step may not occur for instance 2).

Thus it is interpreted that after the determining step of whether the recipient processor is within/not within, the prior art only needs to disclose either: 1) requiring additional information when within; or 2) providing access to the first information to the recipient processor, without requiring the additional info, when that processor has been determined to be outside the region.

Thus, the earlier rejections, meeting this interpretation, are maintained.

**5c. Applicants had earlier argued that the instant application predates Fano (Applicant's Response dated 12/11/08, p. 10). The following is a repeat of the Office's prior response thereto (Office Action mailed 04/02/2009 pages 7-10) to which Applicant has not responded (thus Fano is still valid prior art).**

“ However the instant application presently does not have the benefit of prior-filed application 09/052,746 filed on 03/31/1998 (now U.S. Patent No. 6,154,172) because if applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference

Art Unit: 3688

to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

**(Note:** If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, **the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application.** If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). **This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c).** The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.)

**Here,** such specific reference to the prior filed application including the relationship (i.e., continuation, divisional, or continuation-in-part) is lacking and the later of four months from the actual filing date of the instant application (filing date was March 20, 2001) or sixteen months from the filing date of the prior application (09/052,746 was filed on 03/31/1998) has passed. Thus **a petition needs to be granted to claim priority.** Also the instant Oath or Declaration

Art Unit: 3688

claims priority from provisional application 60191003, filed 03/21/2000, but does not mention prior application 09/052,746.

It is acknowledged the Specification at page 1, states: “*Related Applications*  
*The present invention relates to United States Provisional Application 60/191,003, filed March 21, 2000, which is incorporated herein by reference and from which priority is claimed. The present invention also relates to U.S. Patent No. 6,154,172, issued November 28, 2000 and PCT Application No. PCT/US99/06943, filed March 30, 1999, each of which is incorporated herein by reference.*”

However mere incorporation by reference does not confer benefit of a prior-filed application when the specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) has not been satisfied. See MPEP § 201.11.

**5c i) Further, the burden of establishing prior inventorship is on applicant and must be done by way of an affidavit under rule 131.** (37 C.F.R. § 1.131 requires that the showing be done in affidavit format; has the proper formalities and be signed by the full inventive entity. See MPEP 715.04. No affidavit or declaration has been submitted. Therefore, the rejection stands.

**Applicant argues constructive reduction to practice (Applicant’s Response dated 12/11/08, p. 10, last 4 lines).** The Examiner notes the text of 37 C.F.R. § 1.131 (b) (see below, bold emphasis added) seems to require showing of actual reduction to practice not just constructive reduction to practice. The Examiner also notes that, in the text of 37 C.F.R. § 1.131, (if constructive reduction to practice were to be argued) the date of “filing of the (i.e. instant) application” is important. It is believed case law has extended this to allow for effective filing date of the application (giving credit for 119 and 120 benefit if the claim is fully supported). However, since Applicant does not have the benefit of priority under 35 U.S.C. 119, 120 or 121 (until a properly filed petition is granted), the filing date of 03/31/1998 (for 09/052,746, now U.S. Patent No. 6,154,172) is not the filing date of the (instant) application.

**“37 C.F.R. § 1.131 (Affidavit or declaration of prior invention) :**

- (a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). ...*
- (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of*



Art Unit: 3688

*drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained."*

Applicants are encouraged to consult Ex Parte Schatz et al., USPTO Board of Patent Appeals and Interferences # 2007-1355 (Application SN 10/449,558) decided Sep 21, 2007, holding that an application not in the benefit chain cannot be relied on for constructive reduction to practice. This is a not binding precedent decision but the reasoning may be informative. Without the benefit of 35 U.S.C. 120, at best 09/052,746, now U.S. Patent No. 6,154,172 (if 35 U.S.C. 112 is satisfied) is evidence of conception, not of due diligence, from prior to the effective date of the reference, to the filing of the (instant) application as required by 37 C.F.R. § 1.131.

5c ii) . The Examiner also notes the evidence submitted in the affidavit should clearly be explained to overcome the prior art as applied to each claim. (Just citing the 09/052,746, now U.S. Patent No. 6,154,172 is not sufficient proof of actual reduction showings. Mapping of the 09/052,746 specifications to the claims may be needed.). See e.g. MPEP 715.07, part excerpted below:

*"..The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")."*

### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1),

Art Unit: 3688

(2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**7. Claims 40-41, 45-47, 49-50 and 54-56, 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Fano, US 6317718 B1, herein Fano.**

Fano discloses:

*“An agent based system utilizes a Personal Digital Assistant (PDA)-based, Global Positioning System (GPS)-enabled information gathering agent to create a customized offer information summary based on the location of a user and one or more items of interest. One or more items of interest are obtained from a user. The physical location of the user is determined. A query based on the items of interest and the physical location of the user is then created. A network of information is queried utilizing this query. A customized offer is received from a retailer-based agent in response to the query. The customized offer information associated with the items of interest and their locations relative to the physical location of the user is displayed.”* (Abstract).

**Thus, as to claims 40, 49, 59, Fano discloses:**

A method for controlling the distribution of information from an information provider processor to a plurality of recipient processors on a communications network, based on the geographic locations of the recipient processors the method comprising:

associating a respective positioning system with each respective recipient processor (see at least abstract; col. 47 lines 20-40; Figs. 24-27 and associated text);

receiving location information from each given recipient processor, the location information corresponding to the general geographic location of the given recipient processor (see at least abstract; col. 47 lines 20-40; Fig. 27 and associated text);

Art Unit: 3688

determining, from the location information, whether the geographic location of the given recipient processor is within a predefined location or region (see at least abstract; col. 47 lines 20-40: the user is determined to be within the mall or not);

requiring predefined additional information (implicitly at least the user device ID, which is inherently predefined, is requested by the system for customized suggestions, see at least col. 47 lines 40-66);

before providing each given recipient processor determined to be within the predefined location or region with access to first information (see at least col. 47 lines 61-65: customized suggestions)

As to claims 41 and 50, Fano implicitly discloses wherein requiring additional information comprises communicating a query from the provider processor to the given recipient processor for the additional information (implicitly at least the user device ID is requested by the system for customized suggestions, see at least col. 47 lines 40-66).

As to claims 45 and 54, Fano discloses the methods of claims 40 and 49 and further discloses the additional information comprises current time information (see at least col. 38 lines 54-57).

As to claims 46 and 55, Fano discloses the methods of claims 40 and 49 and further discloses wherein the additional information comprises user identification information (implicitly at least the user device ID is requested by the system for customized suggestions, see at least col. 47 lines 40-66);

As to claims 47 and 56, Fano discloses the methods of claims 40 and 49 and further discloses wherein receiving location information comprises receiving location information over the network by the provider processor and determining comprises determining, by the provider processor, (see at least Figs. 24-25 and associated text: "intelligent agents coordinators", item 2580 of the back end servers 2400 in Fig 25 determine location information of the user devices; see also col. 38 lines 54-57), whether the geographic location of the given recipient processor is within a predefined location or region (e.g., col. 47 lines 20-40: the user is determined to be within the mall or not).

**8. Claims 40 and 49 are alternatively rejected and claims 48 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen, US 6236330 B1, herein Cohen.**

Cohen discloses:

*"A mobile display system comprises one or more movable billboard displays, equipped with externally viewable display panels and a controller. The display is moved from location zone to location zone by a transporter which may comprise a person or a vehicle. The*

*controller ascertains the display location and drives the display to generate a publicly viewable message selected for viewing within such location zone. The message is displayed pursuant to a schedule which includes date, time of day and display duration while the display is within the zone or until the display is located in another zone which is not included within the message schedule. A tiered system control network includes a plurality of fixed stations which transmit message content and scheduling data to the controller and which generate billing and other accounting records. An advertiser may communicate with the network for creating and changing message content and scheduling data.” (abstract).*

Thus as to claims 40 and 49, Cohen discloses:

A method for controlling the distribution of information from an information provider processor to a plurality of recipient processors on a communications network, based on the geographic locations of the recipient processors the method comprising:

associating a respective positioning system with each respective recipient processor (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67);

receiving location information from the positioning system associated with a given recipient processor, the location information corresponding to the general geographic location of the given recipient processor (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67);

determining, from the location information, whether the geographic location of the given recipient processor is within a predefined location or region (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67);

requiring predefined additional information (implicitly at least the user device ID, which is inherently predefined, is requested by the system: see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67) before providing the given recipient processor with access to first information (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line 18; col. 3 line 43 to col. 5 line 67; col. 5 line 62 to col. 6 line 4) in the event that the given recipient processor is determined to be within the predefined location or region.

**As to claims 48 and 57**, Cohen discloses the methods of claims 40 and 49 and further discloses receiving location information comprises receiving location information **by the given recipient processor** and determining comprises determining, by the given recipient processor, whether the geographic location of the given recipient processor is within a predefined location or region (see at least Figs 2-4 and associated text ; col.5 line 46 to col. 6 line 4).

### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**10. Claims 42-44 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Official Notices.**

As to claims 42 and 51,

Fano discloses the methods of claims 40 and 49 but does not specifically disclose the additional information required comprises user age information. However it does disclose querying the user profile (see at least Fig. 13, item 1340 and associated text) in order to provide customized information. Official Notice is taken that it is well-known that consumer profiles comprise age information. It would have been obvious to one skilled in the art at the time the invention was made to add user age information to Fano's teaching of user profiles, in order to further customize information, based on this additional profile factor, the age of the consumer.

As to claims 43 and 52, Fano does not specifically disclose the additional information comprises payment information. However it discloses transaction closing after user location is determined (see at least col. 52 lines 5-8). Official Notice is taken that it is well-known to require some kind of payment information, such as credit card information, in order to conclude a transaction. It would have been obvious to one skilled in the art at the time the invention was made to add requiring payment information to the Fano system, after determining the user location, to allow transaction closing as taught in Fano.

As to claims 44 and 53, Fano does not specifically disclose the additional information comprises a user indication that a waiver, license or disclaimer is accepted. However Official Notice is taken that it is well-known that certain products are sold with warnings or disclaimers. For example some online content to be accessed by the user by download to a user device would be preceded by disclaimers as to the appropriateness of the content. Usually user acceptance of the disclaimer is required before the download can proceed. It would have been obvious to one skilled in the art at the time the invention was made to add requiring such acceptance by the user

Art Unit: 3688

to the Fano teaching of downloading content to the user device, before sending the first information, to ensure the user agrees with the appropriateness of the content before the download.

**ALTERNATE REJECTIONS USING  
Bednarek, US 6009116 A, herein Bednarek.**

**Claim Rejections - 35 USC § 102**

**11. Claims 40-41, 43, 46-47, 48, 49-50, 52 and 55-56, 57, 58-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Bednarek, US 6009116 A, herein Bednarek.**

Bednarek discloses:

*An integrated receiver decoder (IRD), commonly called a set-top box, has a global positioning system (GPS) receiver. The GPS receiver checks to see if the IRD is at an authorized location and allows descrambling of video signals only if the location is authorized. A central access control system, remote from the customers/viewers, has a high quality GPS receiver and sends some GPS data in the transmission medium used to send video signals to the customers. The set-top box, referred to as a customer access control, establishes different geographic restrictions on different of various video signals. Location-specific signals require that the set-top box be at a single fixed location for descrambling. Region-specific signals are accessible only if the set-top box is in a geographic region authorized for reception, there being several such regions. Large area signals are accessible anywhere within a large area including the regions. Region-exclusion signals are accessible only if the set-top box is outside of one or more regions where reception is not allowed.*

**Relevant Figures:**

See Figures 1 (system level); 2 (user device; item 54 shows GPS); 7 (subscription system, definition of regions, identification of user device) , 8 (geographic and non geographic access control attributes) , 12 (determination whether STB within defined boundaries using GPS), 14 (determination of STB in one of the defined regions), Fig 15 (overlapping regions)

**Thus, for claims 40, 49, 58, 59, Bednarek discloses:**

Art Unit: 3688

A method for controlling the distribution of information from an information provider processor to a plurality of recipient processors on a communications network, based on the geographic locations of the recipient processors (see e.g. abstract; Figure 1, item 16 (GPS receiver); item 16: conditional access system; Figure 7 and their associated texts), the method comprising:

associating a respective positioning system with each respective recipient processor for providing location information to the associated recipient processor (see e.g. abstract; Figure 1, item 16 (GPS receiver); item 16: conditional access system; Figure 7 and associated text);

receiving location information from each recipient processor, the location information corresponding to the general geographic location of the given recipient processor from which the location information is received (see at least abstract; Figs. 1 and 7 and associated text; (col. 16 lines 28-32);

determining, from the location information, whether the geographic location of the each recipient processor from which the location information is received is within a predefined location or region (e.g. abstract; col. 16 lines 33-46; e.g. Figs. 7 and associated text; or e.g. Figure 8 items 426, 430 and associated text);

requiring predefined additional information (col. 3 lines 57-65: e.g. subscription payment information required ;e.g. Figure 8 items 424, 430 and associated text; ) before providing each recipient processor determined to be within the predefined location or region access to first information,

**wherein the first information is giving partial but not full access to a service:**

(“Region-exclusion signals are accessible only if the set-top box is outside of one or more regions where reception is not allowed. “ (Bednarek, abstract) means that there is partial access to information (content) inside the region where the exclusion applies, and full access outside that region. See also, e.g. col. 23 lines 59-62: sports event excluded from region R2 of Figure 14, reads on partial access within the region R2, full access outside R2. Also see col. 21 lines 33-36, (discussed in connection with Figure 12): partial access.

(Also see e.g. Figures 7, 14 and associated text, col. 23 lines 30-52: locations restrictions ) ( region exclusion signals (e.g., sports event may be shown in areas only outside of the city, area, or state in which the event takes place: access to some content excluding sports event reads on partial access, within the region e.g. city where event takes place; while full access, i.e. content including sports event, is provided outside the city region)

**or wherein the first information can be giving full access to a service:**

Art Unit: 3688

( “Region-specific signals are accessible only if the set-top box is in a geographic region authorized for reception, there being several such regions.” (abstract) reads on full access within the region, partial access outside the region. Also see e.g. col. 21 lines 29-33 (discussed in connection with Figure 12) reads on full access);

and

**providing each recipient processor not determined to be within the predefined location or region with access to second information without requiring the predefined additional information** wherein the one of the first and second information is a partial access but not full access to a product or service and the other of the first and second information is full access to the product or service:

**\*\*(This providing step is not given weight because all recipient processors can be in the 1<sup>st</sup> predefined location or region, as discussed in the response to arguments section 5b above).**

**\*\*(Note: Also, see below, section 13. “ALTERNATE REJECTIONS USING Bednarek, giving full patentable weight to the “providing” step.”)**

Claims 41 and 50:

Bednarek implicitly discloses wherein requiring additional information comprises communicating a query from the provider processor to each recipient processor determined to be within the predefined location or region for the additional information (implicitly at least the user device ID is requested by the system).

Claims 43 and 52:

Bednarek disclose the additional information comprises payment information (col. 3 lines 57-65: e.g. subscription payment information required).

Claims 46 and 55:

Bednarek discloses the methods of claims 40 and 49 and further discloses wherein the additional information comprises user identification information (implicitly at least the user device ID is requested by the system; see also e.g. Figure 8 items 424, 430 and associated text).

Claims 47 and 56:

Bednarek discloses the methods of claims 40 and 49 and further discloses wherein receiving location information comprises receiving location information over the network by the



Art Unit: 3688

provider processor and determining comprises determining, by the provider processor, (see at least Figure 1 item 16 and associated text; e.g. col. 7 lines 56-59).

Claims 48 and 57:

BEDNAREK discloses the methods of claims 40 and 49 and further discloses receiving location information comprises receiving location information by the given recipient processor (e.g. col. 20 lines 51-58: STB is movable and needs to determine in what region it's located; see e.g. Fig. 12 and associated text )

and determining comprises determining, by the given recipient processor, whether the geographic location of the given recipient processor is within a predefined location or region (citations above; also see e.g. col. 21 lines 51-57))

### **Claim Rejections - 35 USC § 103**

**12. Claims 42, 44, 45 and 51, 53, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek.**

Claims 42 and 51:

Bednarek discloses the methods of claims 40 and 49 but does not specifically disclose the additional information required comprises user age information. However it does disclose parental restrictions (col. 3 lines 57-65). It would have been obvious to one skilled in the art at the time the invention was made to add querying for user age information to Bednarek's teaching of parental restrictions, in order to provide appropriate content based on the age restriction.

Claims 44 and 53:

Bednarek does not specifically disclose the additional information comprises a user indication that a waiver, license or disclaimer is accepted. However Official Notice is taken that it is well-known that certain products or services are sold with warnings or disclaimers. For example some online content to be accessed by the user by download to a user device would be preceded by disclaimers as to the appropriateness of the content. Usually user acceptance of the disclaimer is required before the download can proceed. It would have been obvious to one skilled in the art at the time the invention was made to add requiring such acceptance by the user to the Bednarek teaching of downloading content to the user device, before sending the first

Art Unit: 3688

information, to ensure the user agrees with the appropriateness of the content before the download.

Claims 45 and 54:

Bednarek discloses the methods of claims 40 and 49 and but does not disclose the additional information comprises current time information. However Official Notice is taken that it is well-known to provide content based on time so the content such as advertising would be relevant. Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA") to add to BEDNAREK the additional information being current time information so to provide such time-relevant content.

### **13. ALTERNATE REJECTIONS USING**

**Bednarek,**

**giving full patentable weight to the "providing" step.**

**Claims 40-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek.**

**Claims 40, 49, 58, 59:**

**The first few steps are rejected under Bednareck as discussed above in section 11. "Claim Rejections - 35 USC § 102". For brevity, all the above rejection is herein incorporated by reference.**

**For the providing step, if weight should be given to the whole providing step,** then it would have been obvious to a PHOSITA to decide to give the second information (full access content) for free (i.e. without requiring additional payment information) if desired. Official Notice is taken that promotional campaigns where product or services are given for free for limited periods are old and well-known to attract new customers. Thus it would have been obvious to a PHOSITA to provide Bednarek's 2<sup>nd</sup> information (full access content, to sports events, e.g. outside the event city) for free, for the same well-known promotional purposes, to attract new subscription customers.

**Claims 41-48, 50-57:**

The additional limitations of the dependents claims are disclosed, respectively, as above discussed. For brevity, all discussions as to claims **41-48, 50-57** above, in paragraphs 11 or 12, including Official Notices where applicable, are herein incorporated by reference. The same

Art Unit: 3688

motivations for combination to the instant rejection apply here as well. Thus claims 41-48, 50-57 are rejected similarly as discussed above, for the same reasons.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### **Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grube 5778304 Method for providing communication services based on geographic location; service , including data and graphic transmission, restricted or prohibited if device is within particular region (col. 2 lines 54-67);no restriction if outside the region (col. 3 lines 25-29); device with GPS locator and matching of GPS determined coordinates with database of regions (col. 3 lines 12-23); if there is restriction a message, e.g. text or alert is sent to device (col. 3 lines 31-42) prompting an action which could be automatic or manual (col. 3 lines 42-52). See fig 2. An alternate embodiment (Fig 3) is that a service is granted if device is not within a certain region. Other embodiments include device determining its own location by addressing a database of predefined regions, and reconfiguring its access to services based on defined restrictions or privileges (col. 4 lines 9-21).

Jerger 6321334 (Effective date: 7/15/1998) discloses administering permissions associated with a security zone in a computer system security model; set default levels of security include high, medium, low; prompting users when permission needed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Thursday 9:00-6:00.

Art Unit: 3688

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Robert Weinhardt can be reached on 571-272-6633. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 29, 2009

/Khanh H. Le/

Examiner, Art Unit 3688